

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Phil Kongtcheu
Application No.: 10/518,823
Examiner: Sara Chandler
Filing Date: September 14, 2005
Group Art Unit: 3693
Title: METHODS, SYSTEMS AND COMPUTER PROGRAM PRODUCTS TO FACILITATE THE FORMATION AND TRADING OF DERIVATIVES CONTRACTS

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

OFFICE ACTION RESPONSE: REQUIREMENT FOR RESTRICTION/ELECTION

Madam/Sir:

In response to office action confirmation number 9878 dated August 05, 2008 by examiner Sara Chandler on application number 10/518,823, the claims have been elected and/or restricted with traverse in compliance with 37 CFR 1.143, *as requested*:

Certificate of Electronic Mailing (37 C.F.R. § 1.8)

I hereby certify that this correspondence is being deposited electronically with the United States Patent Office addressed to:
Mail Stop Amendment, Commissioner for Patents,
PO Box 1450, Alexandria, VA 22313-1450, on **September 05, 2008**.

Typed or printed name of person signing this certificate:

Phil Kongtcheu

Signature:



Requirement for Restriction/Election for US Patent Application Number 10/518,823

We assume¹ the examiner means each subcombination identified as having separate utility should be claimed in a separate distinct invention. Applicant therefore traverses the restriction requirement (37 CFR 1.143) on the basis that this request reflects an incomplete understanding of the specification interconnected central insights, namely:

- the all encompassing description format for derivatives,
- the identification and description format for BICs as most elementary component of derivatives,
- and the formula enabling decomposition of any derivatives contract into the elementary components.

The utilities outlined by the examiner in subcombinations 1 to 14 *overlap in scope* because they derive their statutory inventiveness from their relation to the interconnected central insights; none can be brought to separate inventive utility without such a relation. As such all 16 claims *require the particulars* of the central insights and therefore are directed to a *single unitary invention*.

Furthermore, restriction is not proper, there would be no serious burden if restriction were not required, since statutory inventiveness is directly related to *the absence of the central insights in the prior art* for any separate classification, status, or field of search that may apply. Therefore, the applicable conditions set forth in 806.05(d) do not apply.

¹ It is unclear to the applicant whether the examiner means each subcombination identified as having separate utility should be claimed in a separate distinct claim or altogether in a separate distinct invention. The applicant has unsuccessfully tried to reach the examiner by phone on 09/04/2008 to resolve the ambiguity.

Applicant notes that he did beforehand self-applied a restriction requirement to the 273 claims covered in the international application PCT US/03/19179 even though the International preliminary report already accepted it as directed to a single unitary invention.

However, in the event the restriction requirement becomes final, and since applicant's only option in the examiner's interpretation is to choose only a single subcombination as described, applicant elects with traverse the following claim as invention for consideration, corresponding to subcombination 12 outlined by the examiner with the typographic error BICs replaced by derivatives as follows:

14. (178) A method for mediating trading in BICs derivatives comprising:
 - a. establishing a BICs-basis;
 - b. establishing a network to facilitate interaction between stakeholders under the supervision of a trading system management authority ;
 - c. causing said network to communicate with said stakeholders to enable a determination of trading prices for BICs trades ;
 - d. identifying relevant derivatives contracts ;
 - e. decomposing said relevant derivatives contracts to create a portfolio of BICs ; and,
 - f. finalizing a transaction in said portfolio of BICs.